



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Jean DE RIGAL et al.

Group Art Unit: 1614

Application No.: 10/743,455

Examiner: F. KRASS

Filed: December 23, 2003

Docket No.: 118111

For: COSMETIC COMPOSITIONS AND CONTRAST CARDS FOR
CHARACTERIZING THEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This request is being filed with a Notice of Appeal. Review of the January 23, 2008 Final Rejection is requested for the reasons set forth in the attached five or fewer sheets.

Should any questions arise regarding this submission, or the Review Panel believe that anything further would be desirable in order to place this application in even better condition for allowance, the Review Panel is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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WPB:HHS/lmf

Date: June 23, 2008

REMARKS**I. Status of Pending Claims**

Claims 1-32 and 34-48 are pending in this application. Non-elected claims 16-31 have been withdrawn from consideration by the Examiner. Claims 1-15, 32 and 34-38 are rejected. No amendments are being filed with this Request.

II. Grounds of Rejection Presented for Review

The Office Action rejects claims 1-15, 32 and 34-38 under 35 U.S.C. §103(a) as allegedly having been obvious over French Patent No. 2,178,441 to Bourjois ("Bourjois") in view of U.S. Patent No. 5,313,267 to MacFarlane et al. ("MacFarlane"). However, the Examiner fails to properly establish a *prima facie* case of obviousness. Therefore, this rejection is improper and forms the basis for this appeal.

A. Background

Independent claims 1 and 2 recite, in part, a foundation cosmetic composition comprising "at least one coloring agent having a yellow or orange coloration and having a significant reflectance in the range from 550 to 675 nm; and reflective particles, said composition having a reflectance ranging from 10 to 45% in the range from 600 to 680 nm, said composition having a homogenization power $1/\Delta E_1$ and a covering power $1/\Delta E_2$ " for specific values of lightness L^* , when applied to a particular contrast card with a white border (emphasis added).

Independent method claim 32 recites, in part, "A method for making up skin, having a mean lightness L^* measured on the forehead, the cheekbones and the chin, in the CIE 1976 colorimetric space that is less than 60, the method comprising: measuring a colorimetric characteristic of said skin, said colorimetric characteristic comprising at least one of the lightness and saturation, selecting a composition suitable for lightening said skin based on the measured colorimetric characteristic, and applying the selected composition to said skin" (emphasis added).

B. Pertinent Law/ MPEP Sections

The Examiner bears the initial burden of factually supporting any conclusion of *prima facie* obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. See MPEP 2142. "The key to supporting any rejection under 35 U.S.C. §103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." See MPEP §2142, citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007). Furthermore, "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." See MPEP §2142, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Supreme Court are as follows: (A) Determining the scope and content of the prior art; (B) Ascertaining the differences between the claimed invention and the prior art; and (C) Resolving the level of ordinary skill in the pertinent art. See MPEP §2141.

C. Analysis**1. Independent Claims 1 and 2****a. The References Do Not Teach or Suggest Claims 1 and 2**

The Examiner's rejection of independent claims 1 and 2 and the claims dependent therefrom are improper because the combination of the applied references would not have produced the claimed foundation cosmetic composition. Independent claims 1 and 2 recite a foundation cosmetic composition having at least the following limitations: 1) a yellow or orange coloring agent that has significant reflectance in a specified wavelength range; 2) reflective particles; 3) a specified range of percent reflectance at a specified range of wavelengths; 4) a homogenization power within a specified range; 5) a covering power within a specified range; 6) a lightness value L* within a specified range; 7) a hue angle value within

a specified range; and 8) a* and b* as coordinates in the CIE 1976 colorimetric space.

However, Bourjois and MacFarlane, alone in combination, do not teach or suggest a foundation cosmetic *composition* in the first place, much less a composition having the specific combination of the numerous specific limitations required by claim 1.

Instead, as acknowledged by the Office, Bourjois describes "a device enabling one to select the proper makeup hue...so as to provide the optimum overall aesthetic effect" and MacFarlane describes "methods for personal color characterization using skin color as the exclusive determining factor." See pages 4 and 6 of the June 29, 2007 Office Action, respectively. Accordingly, because the composition recited in claims 1 and 2 are not taught or suggested by the applied references, alone or in combination, the combination of the applied references would not have rendered obvious the subject matter of claims 1 and 2. Therefore, the Examiner's rejection of claims 1 and 2 and the claims dependent therefrom is improper.

b. The Examiner Fails to Establish Prima Facie Obviousness

The Examiner fails to establish *prima facie* obviousness of independent claims 1 and 2 and the claims dependent therefrom. The Examiner generally categorizes the specific combination of the numerous specific limitations recited in claims 1 and 2 as "functional parameters," and improperly shifts the burden to the Applicants to demonstrate the unobviousness of claims 1 and 2. See page 2 of the January 23, 2008 Office Action ("Where functional parameters such as the instant hue angle, saturation, covering values, etc. are recited and the prior art discloses otherwise similar prior art, the burden is on the applicant to demonstrate the unobviousness of those parameters"). However, the Examiner fails to first establish how the device taught by Bourjois, or the method of color characterization using skin color as the exclusive determining factor taught by MacFarlane, alone or in combination, teach or suggest a foundation cosmetic composition that is "otherwise similar" to the claimed

foundation cosmetic compositions. Therefore, because the Examiner fails to articulate reasoning with some rational underpinning to support the legal conclusion of obviousness, the Examiner fails to establish a conclusion of *prima facie* obviousness and the rejection of claims 1 and 2 and the claims dependent therefrom are improper.

2. Independent Claim 32

a. The References Do Not Teach or Suggest Claim 32

The Examiner's rejection of claim 32 is improper because the combination of the applied references would not produce the claimed invention. Claim 32 recites, in part, "A method for making up skin, having a mean lightness L* measured on the forehead, the cheekbones and the chin, in the CIE 1976 colorimetric space that is less than 60, the method comprising: measuring a colorimetric characteristic of said skin, said colorimetric characteristic comprising at least one of the lightness and saturation." However, the applied references are silent as to measuring at least one of lightness and saturation of the skin. Accordingly, the combination of the applied references would not have produced the claimed method of making up the skin by measuring at least one of lightness and saturation of the skin, and the rejection is improper.

b. The Examiner Fails to Establish Prima Facie Obviousness

The Examiner also fails to establish a *prima facie* conclusion of obviousness of independent claim 32. The Examiner fails to provide reasoning with some rational underpinning as to how claim 32 would have been obvious over the applied references. Specifically, the Examiner indicates that claim 32 is "drawn to the determination of certain parameters necessary to arrive at cosmetic compositions having the instantly claimed appearances through the application of routine experimentation." See page 3 of the January 23, 2008 Office Action. However, without resolving the level of ordinary skill in the pertinent art in the first place, it is impossible for the Examiner to clearly articulate reasons why the claimed invention would have been obvious to one of ordinary skill in the art.

Therefore, the Examiner cannot support the rejection of claim 32 under 35 U.S.C., and the Examiner's statement that the invention recited in claim 32 is achieved through "the application of routine experimentation" amounts to a mere conclusory statement. *KSR*, 82 USPQ2d at 1396, quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Accordingly, the Examiner fails to establish a *prima facie* conclusion of obviousness of independent claim 32, and the rejection of independent claim 32 is improper.

III. Conclusion

For all of the reasons discussed above, it is respectfully submitted that the obviousness rejection is in error and that claims 1-15, 32 and 34-38 are in condition for allowance. Applicants respectfully request the panel of Examiners to allow this application.